

Docket No.: 2001 P 08524 US
App. No.: 09/863,935

REMARKS

Claims 1-3, 7-11, 15 and 16 are now pending. Claims 1, 7, 9 and 15 have been amended.

Claim Rejections - 35 U.S.C. § 103

The Patent Office rejected claims 1-2, 9-10, 17 and 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,802,314 by Tullis et al. ("Tullis") in view of U.S. Patent No. 5,742,763 by Jones ("Jones").

The Patent Office rejected claims 3, 7-8, 11, 15-16, 19 and 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,802,314 by Tullis et al. ("Tullis") in view of U.S. Patent No. 5,742,763 by Jones ("Jones") and further in view of U.S. Patent No. 6,236,987 by Horowitz et al. ("Horowitz").

Applicants respectfully traverse both rejections. Applicants respectfully submit a *prima facie* case of obviousness has not been established for any one of claims 1, 7, 9 and 15. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Applicant respectfully submits claims 1, 5, 9 and 15 include elements which have not been disclosed by Tullis, Jones or Horowitz, individually or in combination. The present invention allows for pre-filtering whereby messages may only be converted from a first format to a second format if determined urgent based upon a message priority and sender information. This is advantageous since conversion of messages is processing intensive and unwanted messages may be a waste of time for the user. For example, claims 1, 5, 9 and 15 generally recite conversion of messages is based upon a set of user-definable parameters, said set of user-definable parameters including sender information, message priority and summarization rules and wherein messages are only converted when determined urgent based upon sender information and message priority. Tullis, Jones and Horowitz, individually or in combination, fail to teach, disclose or suggest conversion

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of messages is based upon a set of user-definable parameters, said set of user-definable parameters including sender information, message priority and summarization rules and wherein messages are only converted when determined urgent based upon sender information and message priority. The Patent Office states that Tullis fails to disclose utilization of user parameters in conversion of a message. (Office Action of July 12, 2005, Page 4). Jones fails to cure the defects of Tullis. Jones merely mentions the summarization of messages but fails to teach, disclose or suggest the summarization of messages according to user parameters. (Jones, Column 9, Line 48). Jones also fails to teach, disclose or suggest the conversion of messages when determined urgent based upon sender information and message priority. Consequently, an element of claims 1, 5, 9 and 15 has not been taught by Tullis, Jones or Horowitz, individually or in combination. Thus, claims 1-3, 7-11, 15 and 16 should be allowed.


Conclusion

Applicants respectfully submit that all claims are allowable, and it is respectfully requested that the entire application now be passed to formal allowance.

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